Remarks

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of November 2, 2007. In the Office Action, claims 1, 3-11 and 32-37 are pending with claim 1 being an independent claim. Claim 1 has been amended to incorporate the limitations of claim 2. Accordingly, claim 2 has been canceled and claim 3 amended to reference claim 1. Consequently, no new matter has been added and it is not believed that an additional search will be required. Review and reconsideration of the claims are respectfully requested.

Claims 1, 3-11 and 32-37 remain in this application and are believed to be in proper condition for allowance.

A.   Claim Rejections under 35 U.S.C. §103(a)

1.   The Cited Art

The Examiner relied on two prior art documents in his rejection of claims 1, 3, 7-11, and 32-37 under 35 U.S.C. 103(a): U.S. patent application 2003/000084132 to Ohta (Ohta) and U.S. patent application 2001/0039590 to Furukawa, et al. (Furukawa). The Examiner relied on Ohta, Furukawa et al. and U.S. patent application 2002/0078161 to Cheng (Cheng) in his rejection of claims 4-6 under 35 U.S.C. 103(a).

Applicant respectfully disagrees that these references individually or in combination teach each element of applicant's claims. Applicant respectfully urges Examiner to reexamine the asserted grounds for rejection.

2.   Claim 1

The Examiner rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Furukawa. In particular, the Examiner stated that Ohta teaches a method of configuring a peripheral device on a network that includes the elements:

> receiving a response by the host from the peripheral device, the response including a current configuration setting of the peripheral device; and

> determining by the host whether to configure the peripheral device, without user intervention; (Applicant's claim 1, second and third elements).

As support, Examiner cited to Ohta, "client receives the transmitted configuration information from peripheral, paragraph [0059]", "installer stores and activated in automatic mode, paragraphs [0060-0063]", and "without any user operation, paragraph [0032]".

However, Ohta paragraph [0059] cited by Examiner and Figure 6 discloses receiving printer configuration data from the server, not a peripheral, such as a printer.

Further, Ohta paragraphs [0060-0063] cited by Examiner do not refer to determining whether to configure a **peripheral**, but rather determining whether to configure a driver on a **client**. As Examiner will recognize, determining whether to configure a **driver** on a client to access a peripheral is not the same as determining whether to configure the peripheral itself. The driver on the client is software, whereas the peripheral is a piece of hardware. To read on the claim as Examiner has indicated, Ohta must teach receiving a response, including a configuration setting from a peripheral, and determining whether to configure a peripheral, without human interaction.

As used in Ohta, neither the client nor the server constitutes a peripheral. Ohta paragraph [0052] lists example peripherals, ("A printer, which is a preferable example of a peripheral device... a peripheral device includes equipment such as a digital camera, a scanner, etc... a printing device and an imaging device are also preferable examples of a peripheral device"). Therefore, the client and server are distinguished from a peripheral.

In addition, neither the client nor the server determines whether to configure the peripheral. As illustrated by paragraph [0056], the server does not determine whether to configure the peripheral: "Using the virtual printer, *only the setting of the server device is changed when the IP address of the network printer is changed*" (emphasis added). Ohta does not teach determining whether to configure the peripheral, but rather determining whether to configure a *server* when a network printer has already been independently changed. As discussed in detail above, a server is not a peripheral.

Furthermore, as illustrated by paragraph [0056], the client does not determine whether to configure the peripheral: "the physical change of the printer configuration of the server device *can be concealed from the client device*" (emphasis added). Therefore, Ohta teaches away from having the client determine whether to configure the peripheral, as the client does not need to have knowledge of the physical change of the actual printer configuration. Also, determining whether to configure a client does not read on applicant's claim 1 since a client is not a peripheral.

The Examiner rejected claim 2, now incorporated in its entirety into claim 1, under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Furukawa. In particular, the Examiner

stated that Ohta teaches a method of configuring a peripheral device on a network that includes the element:

> sending a configuration message from the host to the peripheral device, the configuration
> message including an updated configuration setting for the peripheral device, the updated
> configuration setting generated and sent by the host without user intervention.

As support, Examiner cited to Ohta, "configuration message setup and then transmitted via virtual printer, paragraphs [0074-0076]". However, the Ohta paragraphs [0074-0076] cited by Examiner do not refer to sending a configuration message to a **peripheral**, but rather sending a configuration message to a **client** using Ohta's virtual printer invention. To read on the claim as Examiner has indicated, Ohta must teach sending configuration message from the host to the peripheral, without human interaction.

Ohta paragraph 0050 states that the client device 501 and server device 502 share printer (peripheral) information; but neither the client nor server determines whether to configure the peripheral itself or send a configuration message to the peripheral itself. Reference numbers 507 and 508 in Examiner cited paragraph [0060] refer to Ohta Figure 6 and show communications only between a client 501 and a server 502, not a peripheral.

Furukawa does not correct the deficiencies of Ohta. Furukawa in combination with Ohta does not teach or suggest the claimed communications between the host and peripheral as required by claim 1. Claim 1 requires receiving a "current configuration setting" and sending a host-generated "updated configuration setting" to the peripheral. Furukawa receives only a MAC address and possibly a printer name (see Figs 1 and 4), and not the current configuration settings of the peripheral. The host in Furukawa sends back only IP information and does not send back

an updated configuration setting. Therefore, Furukawa does not receive a configuration setting that can be updated and sent back to the peripheral. As a result, Furukawa does not disclose receiving current configuration and sending updated configuration settings as disclosed in applicant's application, such as "current device-specific setting, such as, for example, a default scanning resolution for a scanner." (*See* Application, page 6, lines 15 - page 7, line 2). Furukawa does not teach or suggest the required elements of receiving current configuration settings and sending updated configuration settings.

Examiner, in rejecting Applicant's previous arguments, indicated that "Applicant's claim limitations do not necessitate installation of any items on the peripheral let alone any configuration of the peripheral itself represented by claim 1." Applicant respectfully points out that dependent claim 2, now incorporated into claim 1, included the element of sending a configuration message to a peripheral with an updated configuration setting for the peripheral, and that dependent claim 32 included the element of changing the current configuration setting of the peripheral device to match the updated configuration setting included in the packet (the sent configuration message). To progress prosecution of this application to allowance and further distinguish Applicant's claims over the cited art, Applicant has amended independent claim 1 with the entire claim element found in dependent claim 2. No new matter is presented, as the entire claim element from claim 2, as previously examined by Examiner, has been incorporated into claim 1.

In response, Applicant respectfully disagrees with the Examiner that the combination of Ohta and Furukawa disclose, teach or suggest Applicant's claimed invention. There is nothing in the specification, drawings or claims of Ohta directed to receiving configuration settings from a

peripheral or determining whether to configure a peripheral device. Furukawa does not correct the deficiencies of Ohta in receiving a current configuration setting of the peripheral device and sending an updated configuration setting back to the peripheral device.

Therefore, Applicant respectfully contends that Examiner's rejection of claim 1 should be withdrawn, and that Applicant's invention set forth in independent claim 1 is in proper condition for allowance.
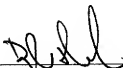
3. Claims 3-11, and 32-37

Regarding rejected dependent claims 3-11, 32-37, Applicant respectfully contends that these claims depend directly or indirectly from allowable independent claim 1. It is well established in patent law that allowance of a parent or base claim as patentable, results in allowance of a claim dependent upon that parent claim. *See* DONALD S. CHISUM, CHISUM ON PATENTS §7.04[2]. As discussed above, Applicant respectfully submits that independent claim 1 is not obvious in light of Ohta and Furukawa. Therefore, because claims 3-11, and 32-37 depend from an allowable independent claim, Applicant respectfully asserts that these claims also are in proper form for allowance. Applicant respectfully requests that Examiner withdraw his rejection and allow these dependent claims to pass to issuance.

C. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, applicant respectfully submits that all pending claims, claims 1, 3-11 and 32-37, are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone or email the undersigned at the numbers provided.

Respectfully submitted,

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